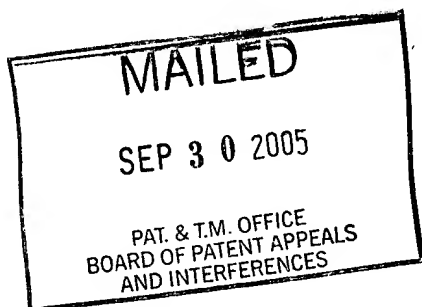




UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Fred E. McKelvey
Telephone: (571) 272-9797
Facsimile: (571) 273-0042



Applicants: Nolan et al.
Application No.: 09/392869
Filed: 09/09/99
For: Catalyst complex with carbene
ligand

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,374.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

Fred E. McKelvey
Senior Administrative Patent Judge

Mail Stop Interference
P.O. Box 1450
Alexandria Va 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042

Paper 1

Filed 30 September 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Senior Administrative Patent Judge McKelvey)

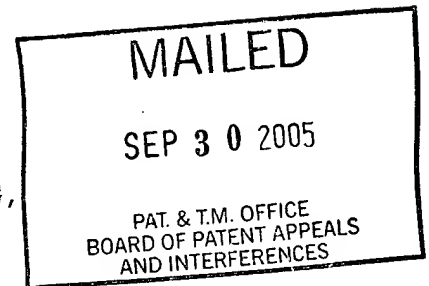
ROBERT H. GRUBBS, DONALD W. WARD,
THOMAS J. SEIDERS and STEVEN D. GOLDBERG,

Junior Party
(Application 10/124,745),

v.

STEVEN P. NOLAN and JINKUN HUANG,

Senior Party
(Application 09/392,869).



Patent Interference No. 105,374
Technology Center 1600

DECLARATION - Bd.R. 203(d)

Before McKelvey, Senior Administrative Patent Judge.¹

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the applications, count and claims designated as corresponding or as not corresponding to the counts appear in Parts E and F of this DECLARATION.

¹ As part of Board efforts under the Government Paperwork Elimination Act, signatures on papers originating from the Board are being phased out in favor of a completely electronic record. Consequently, in this case papers originating at the Board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 C.F.R. § 10.18.

Part B. Judge managing the interference

Administrative Patent Judge McKelvey has been designated to manage the interference. 37 CFR § 41.104(a) [Bd. R. 104(a)].

Part C. Standing order

A Trial Section STANDING ORDER (Paper 2) accompanies this DECLARATION. The STANDING ORDER applies to this interference.

Part D. Initial conference call

A telephone conference call to discuss the interference is set for 1:30 p.m. (1330 hours) on Wednesday, 30 November 2005 (the Board will initiate the call).

No later than **two business days (i.e., Monday, 28 November 2005)** prior to the conference call, each party shall file and serve by facsimile (STANDING ORDER ¶ 4.5) a list of the motions (Bd. R. 120; Bd. R. 204; STANDING ORDER ¶ 26) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. Identification and order of the parties

Junior Party

Named inventors: Robert H. Grubbs, South Pasadena, CA
Donald W. Ward, Altadena, CA
Thomas J. Seiders, San Diego, CA
Steven D. Goldberg, Pasadena, CA

Application: Application 10/124,745,
filed 16 April 2002

Title: Group 8 transition metal carbene
complexes as enantioselective olefin
metathesis catalysts

Assignee: California Institute of Technology

Accorded Benefit: None²

² It is noted that Grubbs claims priority of provisional application 60/284,214 filed 16 April 2001. To the extent Grubbs believes it is entitled to benefit for the purpose of priority of the provisional application, a motion for benefit may be listed in the motions list.

Senior Party

Named Inventors: Steven P. Nolan, New Orleans, LA
Jinkun Huang, New Orleans, La

Application: 09/392,869
filed 09 September 1999

Title: Catalyst complex with carbene ligand

Assignee: University of New Orleans Foundation

Accorded Benefit: None³

³ It is noted that Nolan claims priority of (1) provisional application 60/115,358, filed 08 January 1999 and (2) provisional application 60/099,722 filed 10 September 1998. To the extent Grubbs believes it is entitled to benefit for the purpose of priority of the provisional applications, a motion for benefit may be listed in the motions list.

The senior party is assigned exhibit numbers 1001-1999.
Bd. R. 154(c)(1).

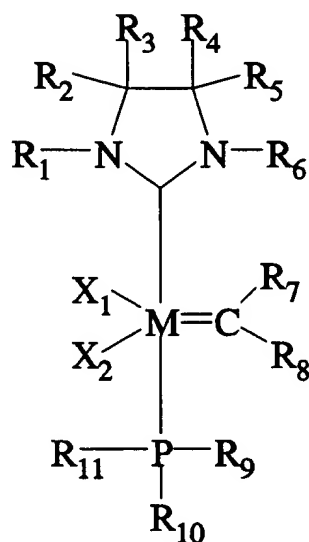
The junior party is assigned exhibit numbers 2001-2999.
Bd. R. 154(c)(1).

The senior party is responsible for initiating settlement
discussions. STANDING ORDER ¶ 18.

Part F. Counts and claims of the parties

Count 1

A composition of matter having the formula:



where:

- M is osmium (Os) or ruthenium (Ru);
- P is phosphorous
- R₁ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₂ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₃ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₄ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₅ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₆ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;

- R₇ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl but cannot be -C=C-YZ, where Y and Z are any moiety;
- R₈ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl but cannot be -C=C-YZ, where Y and Z are any moiety;
- R₉ is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- R₁₀ is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- R₁₁ is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- X₁ is an anionic ligand; and
- X₂ is an anionic ligand.

The claims of the parties are:

Grubbs: 1-34 and 40-75

Nolan: 9, 11-14, 17-21, 23-40, 43-65, 71-73 and 77-111

The claims of the parties which correspond to Count 1 are:

Grubbs: 1-15, 17-34 and 40-75

Nolan: 9, 11-14, 17-21, 23-40, 45-46, 51-63, 65, and 77-78, 89-92 and 107-109

The claims of the parties which do not correspond to Count 1 are:

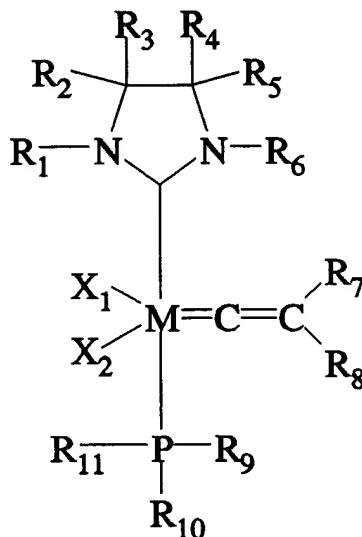
Grubbs: 16⁴

Nolan: 43-44, 47-50, 64, 71-73, 79-88, 93-106 and 110-111

⁴ The subject matter of Grubbs claim 16 is involved in Interference 105,373.

Count 2

A composition of matter having the formula:



where:

- M is osmium (Os) or ruthenium (Ru);
- P is phosphorous
- R₁ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₂ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₃ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₄ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₅ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₆ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;

- R₇ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl but cannot be -C=C-YZ, where Y and Z are any moiety;
- R₈ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl but cannot be -C=C-YZ, where Y and Z are any moiety;
- R₉ is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- R₁₀ is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- R₁₁ is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- X₁ is an anionic ligand; and
- X₂ is an anionic ligand.

The claims of the parties are:

Grubbs: 1-34 and 40-75

Nolan: 9, 11-14, 17-21, 23-40, 43-65, 71-73 and 77-111

The claims of the parties which correspond to Count 2 are:

Grubbs: 1-9, 11-15, 17-34, 40-48 and 64-74

Nolan: 14, 17-21, 23-26, 33-38, 43-44, 47-48, 53-58, 60-62, 77-78 and 90-111

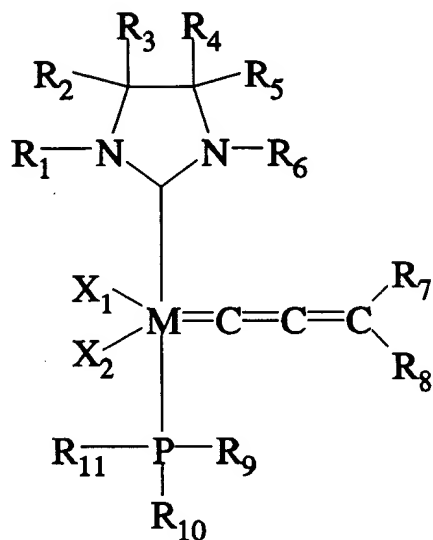
The claims of the parties which do not correspond to Count 2 are:

Grubbs: 10, 16, 49-63 and 75

Nolan: 9, 11-13, 27-32, 39-40, 45-46, 49-52, 59, 63-65, 71-73 and 79-89

Count 3

A composition of matter having the formula:



where:

- M is osmium (Os) or ruthenium (Ru);
- P is phosphorous
- R₁ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₂ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₃ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₄ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₅ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R₆ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;

- R₇ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl but cannot be -C=C-YZ, where Y and Z are any moiety;
- R₈ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl but cannot be -C=C-YZ, where Y and Z are any moiety;
- R₉ is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- R₁₀ is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- R₁₁ is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- X₁ is an anionic ligand; and
- X₂ is an anionic ligand.

The claims of the parties are:

Grubbs: 1-34 and 40-75

Nolan: 9, 11-14, 17-21, 23-40, 43-65, 71-73 and 77-111

The claims of the parties which correspond to Count 3 are:

Grubbs: 1-9, 11-15, 17-34, 40-48 and 64-74

Nolan: 9, 11-14, 17-21, 23-38, 43-44, 49-62, 77-78, 90-92 and 107-109

The claims of the parties which do not correspond to Count 3 are:

Grubbs: 10, 16, 49-63 and 75

Nolan: 39-40, 45-48, 63-65, 71-73, 79-89, 93-106 and 110-111

Part G. Heading to be used on papers

The heading in STANDING ORDER Form 1 must be used on all papers filed in this interference. See STANDING ORDER ¶ 7.2.1. The administrative patent judge and parties must be indicated as follows:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Senior Administrative Patent Judge McKelvey)

ROBERT H. GRUBBS, DONALD W. WARD,
THOMAS J. SEIDERS and STEVEN D. GOLDBERG,

Junior Party
(Application 10/124,745),

v.

STEVEN P. NOLAN and JINKUN HUANG,

Senior Party
(Application 09/392,869).

Patent Interference No. 105,374
Technology Center 1600

Part H. Order form for requesting file copies

When requesting copies of files, use of STANDING ORDER Form 4 will greatly expedite processing of the request. Please attach a copy of Part E of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

Part I. Required paragraph for affidavits and declarations

The Board has recently experienced a rash of cases in which a witness has belatedly advanced reasons why he or she would be unable to appear for cross examination at a reasonable time and place in the United States. Consequently, the Board is requiring the following paragraph to be included on the signature page of all affidavits (including declarations) filed in this case to prevent surprise and hardship to the party relying on the testimony of the witness:

In signing this affidavit/declaration, I recognize that the affidavit/declaration will be filed as evidence in a contested case before the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I also recognize that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.

Enc (there is no Form PTO-850):

STANDING ORDER (Paper 2)
Bibliographic data sheet provisional application 60/284,214
Provisional application 60/284,214
Claims application 10/124,745
Claims application 09/392,869
Bibliographic data sheet application 10/124,745
Bibliographic data sheet application 09/392,869
Specification application 10/124,745 (as filed)
Oath application 10/124,745
Amendments to specification of applicatoin 10/124,745
Drawings application 09/392,869
Specification application 09/392,869 (as filed)
Provisional application 60/099,722
Provisional application 60/115,358
Stevens, "Polymer Chemistry," pages 285-289 (1990)
Collman, "Principles and Applications of
 Organotransition Metal Chemistry," pages 591-592

Revised January 2005

cc (via overnight delivery):

Attorney for Grubbs
(real party in interest
California Institute of Technology):

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Email: reed@reedpatent.com

Attorney for Nolan
(real party in interest
University of New Orleans Foundation):

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Two Embarcadero Center
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Tel: 415-576-0200
Fax: 415-576-0300
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Attorney for the United States [28 CFR § 0.45(f)]:

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Civil Division
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1100 L Street, N.W.
Room 11116
Washington, D.C. 20530

Tel: 202-514-7223
Fax: 202-307-0345